

S/N 10/038,766
Ref. No.: 659-919

REMARKS

In an Office Action mailed October 6, 2003, the Examiner rejected claims 17-20 as being indefinite under 35 U.S.C. 112(2). Applicants have amended claims 17-20 to overcome the Examiner's rejections as set forth above. None of these amendments has narrowed the scope of those respective claims.

In addition, Applicants noted a grammatical error in the specification and various claims concerning the shape of the outer surface of the carrier member, including a top portion 48 and a recessed portion 50. In particular, the top portion 48 and recessed portion 50 are described as being "concave" surfaces, when in fact the surfaces are "convex" as consistently shown throughout the Figures (see e.g., FIGS. 1 and 5A-9). Accordingly, the specification and claims have been amended to correct this grammatical error and to conform those passages to the drawings.

The Examiner has rejected independent claims 1, 9 and 15 as being anticipated by U.S. Patent No. 4,608,115 to Schroth, claim 1 as being anticipated by U.S. Patent No. 4,081,301 to Buell, and independent claim 17 as being anticipated by U.S. Patent No. 4,578,133 to Oschefsky. Because Schroth, Buell and Oschefsky fail to disclose or suggest all of the recitations of the pending claims, inherently or otherwise, the Examiner's rejections should be withdrawn.

Claim 1:

First, Applicants have amended claim 1 to clarify that the "outer surface [includes] a generally *convex* top portion and a generally *convex* recessed portion spaced inwardly from said top portion." As shown in Schroth, the surface 119 is substantially planar, not curved, and even the grooves 116 and 118 are either planar or concave in shape, not convex as set forth in claim 1. Moreover, the grooves 116 and 118 of Schroth are not "adapted and configured to engage at least one portion of the

S/N 10/038,766
Ref. No.: 659-919

discrete part,” as set forth in claim 1, but rather are merely provided to distribute a vacuum pressure (Col. 5, lines 42-45).

Second, claim 1 now recites the recitations of claim 5, which has been cancelled. As acknowledged by the Examiner, Buell did not disclose or suggest those limitations. Applicants concur. In addition, Applicants submit that there is no suggestion to modify the roll 23 of Buell to include a vacuum as the roll is provided to apply a backsheet 5 and adhesive 7 over an absorbent pad element, with the combination thereof exiting the nip rather than being adhered to the roll 23, for examples by way of a vacuum (Col. 7, lines 13-16).

For these reasons, neither Schroth nor Buell discloses all of the limitations of claim 1 and the Examiner’s rejections should therefore be withdrawn.

Claim 9:

Applicants have amended claim 9 to recite that the “outer surface of said at least one transfer assembly includes a top surface having a generally convex shape.” Accordingly, claim 9 is allowable over Schroth for the same reasons set forth above with respect to claim 1.

Claim 15:

Claim 15 recites that the “outer surface of *said web conveyor* [includes] at least one recessed portion for engaging at least one portion of each of the discrete parts that is relatively thicker than other portions of each of the discrete parts,” not that the outer surface of the *transfer assembly* includes a recessed portion. One exemplary embodiment of this invention is shown in Figure 9. Nowhere does Schroth disclose or suggest that *a web conveyor* have a recessed portion. Moreover, the web 22 of Schroth is not a web conveyor having a surface for supporting and advancing a

S/N 10/038,766
Ref. No.: 659-919

substrate web, but rather constitutes the substrate web itself (see e.g., Col. 4 lines 50-55; FIG. 3A). For these reasons, Schroth fails to disclose all of the limitations of claim 15 and the Examiner's rejection should be withdrawn.

Claim 17:

Claim 17 recites a transfer assembly having an "*outer surface including at least one recessed portion* for engaging at least one portion of the discrete parts that is relatively thicker than other portions of the discrete parts." In this way, claim 17 recites that the recessed portion *is part of* the outer surface, which recessed portion receive or engages part of the discrete part. In contrast, the vacuum supplying openings in the top surface of one of the flexible strips, as disclosed in Oschefsky (Col. 7, lines 50-52) and recited by the Examiner as the recessed portion, do not make up any part of the *outer surface* and are not capable of engaging or supporting any material, but rather necessarily extend into the flexible strip and communicate with a vacuum supply. Indeed, instead of making up a portion of the *outer surface*, they provide a *void* in the outer surface. For these reasons, Oschefsky fails to disclose all of the limitations of claim 17 and the Examiner's rejection should be withdrawn

CONCLUSION:


After Amendment, this application has nineteen claims, including four independent claims. Applicants previously paid for twenty claims including four independent claims. Accordingly, no additional claims fee is believe to be due. If for any reason this application is not considered to be in condition for allowance and an interview would be helpful to resolve any remaining issues, the Examiner is respectfully requested to call the undersigned attorney at (312) 321-4713.

S/N 10/038,766
Ref. No.: 659-919

Respectfully Submitted,

Dated: January 6, 2004

By:



Andrew D. Stover
Reg. No. 38,629
Attorney for Applicants

BRINKS HOFER GILSON & LIONE LTD.
Post Office Box 10395
Chicago, Illinois 60610
(312) 321-4200